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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,599	08/25/2003	Bhavesh Mehta	50269-0558	4272

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EXAMINER	
CARLSON, JEFFREY D	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
12/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/648,599	MEHTA ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-28 and 30-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-28 and 30-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/3/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the paper(s) filed 9/23/2009.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 21-28, 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carruthers et al (US2002/0128904).

3. Regarding claims 21, 23, 25, Carruthers et al teaches systems and methods for selecting an ad to include with a request for web content having an ad slot (i.e. ad opportunity), responsive to the content request [¶ 7, 8, 26, 76]. Carruthers et al provides a prioritized master list of ads which provides an order for the ads to be displayed [¶ 34]. Each ad has a predefined delivery criteria that is compared to the ad opportunity in order to determine a qualifying subset of ads from the prioritized master list. The ad chosen from the qualifying subset of the master queue is taken to be chosen based upon the sequence of the prioritized queue. Carruthers et al prioritizes the queue of ads based upon priority, a weighting indicating the number of impressions needed and based upon feedback from the system regarding which ads have been shown [¶ 34, 35]. Further, Carruthers et al states that new, proposed campaigns are analyzed and added to the system if they can be accommodated based on the expected ad inventory [¶ 8]. Carruthers et al therefore recognizes that the slot inventory is limited

and that all requesting advertisers cannot necessarily be satisfied. Carruthers et al put to use a well known concept of “first-come first served” in that the first advertisers to make ad campaign contracts with the system of Carruthers et al are more likely to be accepted and to get their ads shown by the system than latecomers. It would have been obvious to one of ordinary skill at the time of the invention to have given further improved treatment to early advertisers by employing such a well known “first come, first served” notion and included prioritization of the master list of scheduled ads based upon when the advertisers contracted with the system, by comparing stored contract dates among advertisers. In this manner, ad campaigns of late coming advertisers may be accepted into the system, but would be given lower priority (i.e. placed toward the end of the queue) than earlier-arriving advertisers and such latecomers could not steal ad opportunities from earlier-arriving advertisers, even if the latecomers had ad contracts which were more “behind schedule”. The "stealing" by latecomers referred to above addresses the situation where the latecomers have a contract that if fulfilled would prevent fulfillment of an earlycomer’s contract. Late-arriving advertisers would only be served if ad inventory (available slots) was plentiful enough to fully serve the advertisers who came before them. This is consistent with Carruthers et al’s disclosure that early adopters will be accommodated, yet late adopters will not. Further, it is pointed out that applicant’s system merely lets those at the front of the line dictate how much is left for others behind them in line – much like the well known “first come, first served” approach. Regarding applicant’s claimed “slot” and “slot attributes" corresponding to the subject of the requested content, it is first noted that Carruthers et

al takes web surfing users who are requesting various web pages on the Internet [¶ 0016] and seeks to "optimize the use of surplus [*screen*] real estate" by augmenting the requested web page content with advertising such as by including a relevant banner ad [¶ 0015]. These requested web pages represent advertising opportunities having surplus screen real estate (slots where banners are to be inserted – i.e. at the top or bottom, etc., of the page or where else the page designer desires to include advertising) and the system will seek to fill this surplus real estate (slots) with inserted banner advertising. This opportunity to fill surplus real estate (slots) with ads is recognized and the system will choose an appropriate ad by matching the ad targeting criteria with the user profile [¶ 38]. This user profile used for targeting includes the user's history of websites visited, so it is dependant on specific webpages. It is important to note here that US patent application 09/558,755 ("Method and System for Web User Profiling And Selective Content Delivery") is incorporated by reference into Carruthers et al [¶ 0014]. This 09/558,755 application describes in more detail the makeup of the user profile used by Carruthers et al to select ads to fill the ad slots. 09/558,755 describes that the user profile includes the user's "content affinity" (sports, movies, music, etc.,) which is derived using URLs the user has visited in the past *as well as the URL currently being requested/*browsed [pg 8: lines 15-17] and by (Neilson's) profiling of various website content indexed by URL [09/558,755 – page 7 line 21 to page 15]. From page 15:

> For each visit to a Web site having a stored profile, the Web site profile is averaged or combined into the user's profile as previously discussed. The profiles include a rating in each category that reflects the interest in the category of persons who access the Web site.

Stated simply, because the user profile of Carruthers et al includes the subject/category for the page content currently being requested/browsed, the targeted banner advertisement insertion into the surplus web page space therefore meets applicant's claimed slot attributes corresponding to the content subject. Alternatively given such a teaching, it would have been obvious to one of ordinary skill at the time of the invention to have inspected the user profile or inspected the current page at any time or re-ordered the ad queue at any time, including for each advertising opportunity so that an ad can be operably targeted to the current page content as desired by the incorporated material. One of ordinary skill would have recognized the predictable advantage of targeting to current page content as the user is presumably already in the state of mind consistent with that current page content. For example, while the user is reading an article about the local sports team makes a great time to target advertising for that teams ticket plan. It would have been obvious to one of ordinary skill at the time of the invention to have provided the greater ability to finely target ad content to current page content. Further by checking the users profile, the advertising can be targeted to the most up-to-date profile and can take into consideration the user's current online session. Further still, Carruthers at al teaches that some advertising can be inserted according to a keyword being presented entered or to the present URL [0076].

4. Regarding claims 22, 28, Carruthers et al teaches that ads have delivery constraints such as maximum impressions or time between impressions [0039]. If this is the case, the ad is removed from the qualifying subset so that it is not showed for the current opportunity. This is taken to provide a step of including only ads that are not on

track to be satisfied and removing all ads whose constraint is "on-track" or has been met. Alternatively, Carruthers et al teaches that each ad has delivery obligations and that determinations are made regarding whether the ad is "on track" or not. Carruthers et al demotes ads if they are on-track or have already met their delivery goals by moving them towards the bottom of the queue [¶ 35]. Carruthers et al states that ads ahead of schedule (i.e. on-track) are "effectively shut-off" by being placed at the end of the queue. Although this is taken to be effectively removed from the list, it would have been obvious to one of ordinary skill at the time of the invention to have removed such ads from the list entirely in order to ensure only ads that are behind schedule are selected. Further, one of ordinary skill would have found it obvious to have created a subset of ads by either starting with an entire collection and eliminating ads that don't belong, or by merely building the subset by selectively including only ads that do belong. Either approach leads to the same, predictable result (the intended subset).

5. Regarding claims 24, Carruthers et al teaches that the ads are targeted to the users by matching metadata about the ads to the user's metadata (profile) [¶ 38 lines 4-5].

6. Regarding claims 26, Carruthers et al does not appear to specify or restrict the type of content requested to a particular format in order to include the specified advertising. Carruthers et al teaches that the ads can be banner ads or pop-up ads [¶ 15]. Carruthers et al further states that users can access files of various types via the Internet (text, images, video, etc) [¶ 20]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such advertising associated with any

type of electronic content such as a video stream, or even a web page that includes an embedded video stream as is well known, so that advertisers can reach a wide audience and content providers can earn advertising revenue for a variety of pages.

7. Regarding claims 27, Carruthers et al teaches default or filler ads that are used when no other ads are applicable for that user/slot/opportunity. This is taken to be a teaching that when there are indeed targeted ads that qualify (i.e. ads in a fist priority class), that the default ads (i.e. ads in the second priority class) are not to be considered for insertion. It would have been obvious to one of ordinary skill at the time of the invention to have excluded such default ads when the "normal" ads are available. One of ordinary skill would have found it obvious to have created a subset of ads by either starting with an entire collection and eliminating ads that don't belong, or by merely building the subset by selectively including only ads that do belong. Either approach leads to the same, predictable result.

8. Claims 30-37 are rejected with the same reasoning as claims 21-28.

Response to Argument

9. Applicant continues to argue that Carruthers et al fails to teach or suggest selecting an earlier contracted ad rather than a later contracted ad when the later contracted ad is more behind. As resolved by the Board, this feature is obvious given the disclosure of Carruthers et al. Applicants now argue that Carruthers at al need not select an ad based upon time of contract because of Carruthers at al "pre-acceptance filtering". However, as even applicant is aware, the contract-selection guidance offered

by the inventory manager is based on an estimation of future ad opportunities. Therefore one of ordinary skill would recognize that turning away business (refusing to accept contracts) base on an estimation would be unwise. What if the estimate was wrong? Underestimating that there will be 1000 ad opportunities when in fact 1050 ad opportunities become reality deprives the system of the revenue for the unexpected 50 extra ad opportunities. Likewise overestimating that there will be 1000 ad opportunities when in fact 950 ad opportunities become reality would lead to an overbooking situation where the system promises advertising opportunities that can't be fulfilled and therefore not everyone gets satisfied. In both of these cases, the well known notion of a first come first served principle would be obvious to employ when selecting ads for insertion. That is, use time-of-contract-acceptance as a parameter in ad selection. Latecomers would be accepted, but not guaranteed any/all of their opportunities. In the first example where underestimation occurred, the latecomer would be happy to learn that extra opportunities became available. In the second example of overestimation, it would be clear why the latecomer was not 100% fulfilled – i.e. because the opportunities were not as plentiful and they had to go to earlycomers. It strikes the examiner as similar to flying on an airline as a stand-by passenger. All seats have been sold, but there may be a chance that extra seat opportunities become available (i.e. not all ticketed passengers show up) . Maybe they will have room for you (even though the estimation is that they will not), but they tell you to wait until the plane actually fills up or not. If there is still room after the earlier-arrived-customers are seated, the airline can consider people according to their stand-by status. If there not enough extra seats

become available the latecomer knows why – they were too late. It would have been obvious to have used 1st-come, 1st served as part of the ad prioritization process (i.e. after and separate from the steps of actually forming the contracts).

10. Applicant argues that first-come first-served is an entirely different approach. However one of ordinary skill would see how such an approach can be used to augment the explicit pre-acceptance filtering of Carruthers at al – at least for the reasons of accommodating more people than you first estimated; this enables the business to sell more inventory.

11. Applicant argues that Carruthers at al teaches creating the ad order at the time of user login and therefore does not have the ability for ad order to change according to a the content of a presently viewed page. Examiner first points out that Carruthers at al incorporates by reference the teaching that ad targeting can be based upon user page history as well as the currently viewed page content. Given such a teaching, it would have been obvious to one of ordinary skill at the time of the invention to have inspected the user profile or inspected the current page at any time or re-ordered the ad queue at any time, including for each advertising opportunity so that an ad can be operably targeted to the current page content as desired by the incorporated material. One of ordinary skill would have recognized the predictable advantage of targeting to current page content as the user is presumably already in the state of mind consistent with that current page content. For example, while the user is reading an article about the local sports team makes a great time to target advertising for that teams ticket plan. It would have been obvious to one of ordinary skill at the time of the invention to have provided

the greater ability to finely target ad content to current page content. Further by checking the users profile, the advertising can be targeted to the most up-to-date profile and can take into consideration the user's current online session. Further still, Carruthers at al teaches that some advertising can be inserted according to a keyword being presented entered or to the present URL [0076].

12. Applicant argues that Carruthers et al lacks slots and lacks slots which have ad-filling attributes corresponding to the content subject. This is addressed in detail above as written in the previous action. Applicant again argues this point by saying that the ad-filled screen real estate of Carruthers at al is not a slot because this real estate is related to a user's viewing space, not the content. Examiner disagrees. The advertising banners chosen by Carruthers which are presented on and according to the content of the presently requested page are inherently taken to reside in slots.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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jdc